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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,686	11/16/2001	Lee Kirby Jameson	17,090B	2950

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EXAMINER	
REICHLE, KARIN M	
ART UNIT	PAPER NUMBER
3761	

DATE MAILED: 10/08/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/990,686	JAMESON ET AL.	
	Examiner	Art Unit	
	Karin M. Reichle	3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 August 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) *1-11,24 and 25* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *12-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 November 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *8-9* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group II in Paper No. 11 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 1-11 and 24-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 11.

The restriction requirement set forth in Paper No. 10 is still deemed proper and made FINAL.

Specification

Drawings

3. The petition to accept color photographs filed 11-27-01 has been placed in the application. It should be noted that such petition is decided by the SPE. Therefore, the application will be forwarded to the SPE after mailing of this action for decision of the petition. It should be noted that the substitute drawings filed 4-15-02 includes only one set of the photographs.

4. The drawings are objected to because the description of the Figures as illustrations and the Figures, which are photographs, are inconsistent. A proposed drawing correction or

corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Description

5. The abstract of the disclosure is objected to because terminology which can be inferred, i.e. "The present invention relates to", "A second embodiment of the present invention is directed to", "A third embodiment is directed to ", should be avoided. Correction is required. See MPEP § 608.01(b).

6. The disclosure is objected to because of the following informalities: 1) The definition of a "personal care product" on page 5, second full paragraph, and that in claim 21 is inconsistent, e.g. the claim specifies a surgical gown but the definition does not. 2) As discussed supra the description of the Figures as illustrations and the Figures which are photos are inconsistent. 3) The first full paragraph on page 9 is incomplete.

Appropriate correction is required.

Claim Objections

7. Claims 15-16 are objected to because of the following informalities: in claims 15 and 16, line 1, after "the"(first), --one or more-- should be inserted. In claim 16, line 1, "chemistry" should be --chemistries--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. Claims 17, and 21-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 17, a positive antecedent basis for "the application of topography" should be defined. In regard to claims 22-23, a positive antecedent basis for "the discrete segments" should be defined. In claim 22, a positive structural antecedent basis for "the body-facing surface" should be defined. It is unclear what "the personal care product" as claimed in claim 21 is since what it is as set forth in the specification and what is set forth in the claim are not the same, e.g. are surgical gowns considered a "personal care product" or not?

Claim Language Interpretation

9. "Chemistries" is interpreted in light of on page 8, lines 20-25. "Phase change liquid" is defined as set forth on page 5, fourth full paragraph and page 7, first full paragraph. "Nonwoven" is defined as set forth on page 5, first full paragraph. "Personal care product" as best understood, see discussion supra, is defined as set forth on page 5, second full paragraph. "Topography of chemistry" is interpreted in light of page 8, lines 3-9.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 12-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Coles et al '642.

See Figures, i.e. substrate is 12 and the chemistries are 34, 36. See also claim interpretation section supra, and Coles et al at abstract(applies to claim 12, last section and claims 14-21), col. 1, line 55-col. 2, line 11 and 24-30(applies to claim 12, last section and claims 14-19), col. 3, lines 15-22 and 25(applies to claim 12, lines 1 and 3-4), col. 8, lines 65 et seq(applies to claim 12, lines 3-4) and col. 5, line 43-col. 6, line 30(applies to claim 13).

12. Claims 12-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Ouellette et al, '643.

See Figures, i.e. substrate is 128 and the chemistries are 136. See also claim interpretation section supra, and Ouellette et al at abstract(applies to claims 12-22), col. 1, lines 13-17(applies to claims 13, 20 and 21), col. 4, lines 57-65(applies to claim 13), col. 5, lines 18-60(applies to lines 3 et seq of claim 12, claims 14-19 and 22), col. 6, lines 17-32(applies to the last two lines of claim 12, claims 14-19 and 22).

13. Claims 12 and 14-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Webster '787.

See Figures, i.e. substrate is 3 and the chemistries are 2. See also claim interpretation section supra, and Webster at abstract(applies to claims 12, 14-21), paragraph bridging cols. 1-

2(applies to claim 12, last two lines, claims 16-19), col. 3, lines 14-22(applies to all the claims), col. 4, line 1-col. 5, line 14(applies especially to lines 3-4 of claim 12, claims 14, and 22-23) and col. 7, lines 22-31(applies to lines 3-4 of claim 12) and Example 3(applies to claim 23). For example, 5 to 400 nanoliters is equal to .005 to 4 cubed mm and a pyramid as set forth on col. 4, lines 56-61 and lines 44-46 when the projection is .1 mm would include a volume between .191 and .2 cubed mm., i.e. between 5 and 400 nanoliters.

14. Claims 12-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Di Luccio et al '129.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claims 12, 16, 22: see the claim interpretation section supra, Figures, paragraph 52 and paragraph 51 of '129, i.e. the substrate is 40 and the chemistries are 44. With regard to claim 13, see paragraph 32. With regard to claims 14-15, see paragraphs 43-45. With regard to claims 20-21, see paragraph 24. With regard to claim 23, see claim 14 of '129. With regard to claims 17-19, these claims recite properties, functions and capabilities of the claimed structure. Since the Di Luccio et al reference teaches the same structure, there is sufficient factual evidence for one to conclude that such properties, functions and capabilities of the claimed structure are also inherent in the same structure of Di Luccio, see MPEP 2112.01.

Double Patenting

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Claims 12-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-22 of copending Application No. 09/990,697(2002/0087129). Although the conflicting claims are not identical, they are not patentably distinct from each other because since the instant application was filed after the effective filing date of the '697 application, the one way In re Vogel test applies, i.e. are the claims of the instant application obvious in view of the claims of the '697 application? The answer is yes. With regard to claims 12, 14-16 and 20-22, see claims 14-22 of the '697 application as well as the definition of terms in paragraphs 18, 21, 24, 36-42 of '129, especially the last sentence of paragraph 39(and thereby, e.g., col. 13, line 56-col. 14, line 10 of '934 and col. 18, lines 10-30 of '890, i.e. phase change). Note also paragraph 52 and claim 16 of '129. Attention is also reinvited to the claim interpretation section supra. Therefore, the instant application with regard to the enumerated claims is broader than the '697 claims. Furthermore, once an applicant has received a patent for a species on a more specific embodiment which

would be the case if the '697 issued, he(she) is not entitled to a patent for the generic or broader invention. This is because the more specific anticipates the broader. See In re Goodman, supra. With regard to claim 13, the instant application claims more specific types of substrates than merely the porous substrate claimed in claims 14-22 of '697. However, porous materials of film, woven, nonwoven, paper and laminates or combinations thereof are well known in the absorbent article art for forming topsheets. Therefore, to employ such types of porous materials as the topsheet in the claims of '697 would be obvious to one of ordinary skill in the art in view of the recognition that such materials are porous and the desire of a topsheet of porous material by the '697 claims. In regard to claims 17-19, such claims recite properties, functions or capabilities of the claimed structure. The '697 claims include the structure claimed and disclosed as providing such properties, functions and capabilities in the instant application, e.g. semicircular cross section, medicament compositions including lotions and waxes, discrete segments of the disclosed and claimed height. Therefore there is sufficient factual basis for one to conclude that the properties, function and capabilities of the claimed structure would also necessarily and inevitably flow from the same structure of the '697 claims. With regard to claim 23, the claim recites a more narrow range of volume than that of the '697 claims. However, where the general conditions of a claim are disclosed in the prior art, e.g. skin health benefits and the general range in the '697 claims, it is not inventive to discover the optimum or workable ranges by routine experimentation, see In re Allen et al, 105 USPQ 233.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

17. Claims 12-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 19-21, 24, 26-29, and 33 of copending Application No. 09/991,185(2003/0095167). Although the conflicting claims are not identical, they are not patentably distinct from each other because since the instant application was filed on the same day as the '185 application, the one way In re Vogel test applies, i.e. are the claims of the instant application obvious in view of the claims of the '185 application? The answer is yes. With regard to claims 12-15 and 20-23, the method as claimed in the claims of '185 necessarily and inevitably produces a product including the structure as claimed in these claims. In regard to claims 16-19, such claims recite properties, functions or capabilities of the claimed structure. The '185 claims produce structure the same as that claimed and disclosed as providing such properties, functions and capabilities in the instant application, e.g. semicircular cross section, medicament compositions including lotions and waxes, discrete segments of the disclosed and claimed height. Therefore there is sufficient factual basis for one to conclude that the properties, function and capabilities of the claimed structure would also necessarily and inevitably flow from the same structure produced by the '185 claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Common Ownership

18. Claims 12-23 are directed to an invention not patentably distinct from claims 14-22 of commonly assigned 09/990,697('129). Specifically, see discussion in double patenting rejections supra.

19. The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned '697 and '185, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 35 U.S.C. 103(c) and 37 CFR 1.78(c) to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Chen et al patent also teaches a substrate with hydrophobic chemistries.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (703) 308-2617. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (703) 308-1957. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

K.M. Reichle
Karin M. Reichle
Primary Examiner
Art Unit 3761

KMR